



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/899,819	07/09/2001	Michael Chen	SUND 214	9642
23995	7590	12/15/2004	EXAMINER	
RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005			CARTER, TIA A	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/899,819

Applicant(s)

CHEN, MICHAEL

Examiner

Tia A Carter

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5-8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 9-11, 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peek (US. 6614551) in view of Parks et al. (US. 5877746).

Regarding claim 1, Peek discloses a paperless image fax-scanning apparatus,

*K44* 100  
(figure 3), comprising:

An image scanning unit (140) for scanning a document to generate an image data (fig. 3, col. 3, lines 15-16);

*K44*  
A faxing unit (100) connected to a telephone line (180) for transmitting the image data generated from the image-scanning unit or received image data via the telephone line (fig. 3, col. 3, lines 11-17 and col. 4, lines 53-57);

An input interface (keyboard 160), which comprises an operation keyboard for inputting operation signals into the image fax-scanning apparatus (fig. 3, col. 3, lines 27-32 and lines 37-41);

A control unit (processor 110) for controlling the operation of the image fax-scanning apparatus (fig. 3, col. 3, lines 48-5 and col. 4, lines 5-10);

Peek **discloses** a data storage unit (memory 120).

Peek **do not disclose** a data storage unit, which can be connected to a portable data storage medium for storing the image data received by the faxing unit in the portable data storage medium.

Parks et al. **disclose** a data storage unit (disk 45), which can be connected (I/O controller 46) to a portable data storage medium for storing the image data received by the faxing unit in the portable data storage medium (fig. 10, col. 21, lines 10-30).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the memory 120 would have a an interface connected thereto to provide use of additional components such as a memory unit for overflow data and to have capabilities of other devices by uploading information stored for user's usage.

Regarding claim 2, Peek discloses the paperless image fax-scanning apparatus of claim 1, further comprising:

A network interface through which the paperless image fax-scanning apparatus can be connected to a local area network (LAN) (fig. 3, col. 5, lines 40-42).

Regarding claim 3, Peek discloses the paperless image fax-scanning apparatus of claim 2m wherein the LAN is a local Area Network with Ethernet protocol (fig. 3, col. 5, lines 10-16 and lines 40-42).

Regarding claim 4, Peek discloses the paperless image fax-scanning apparatus of claim 1, further comprising:

A printer interface (146) for connecting the image fax-scanning apparatus to a printer through which the fax image data received by the fax unit can be printed out (fig. 3, col. 3, lines 12-20).

Regarding claim 5, Peek discloses the paperless image fax-scanning apparatus of claim 1, further comprising:

A display panel (170) for displaying the operation data inputted by the user and the status of the image fax-scanning apparatus (fig. 3, co. 3, lines 33-36).

Regarding claim 9, Peek disclose the paperless image fax-scanning apparatus of claim 1, wherein the control unit (110) selectively transfers the image data generated from the image scanning unit to the data storage unit (120) (fig. 4a, col. 5, lines 65-67) or stores the data in the portable data storage media.

Regarding claim 10, Peek discloses the paperless image fax-scanning apparatus of claim 9.

Peek **does not disclose** wherein the control unit is further able to selectively have the faxing unit transmit the image data stored in the portable data storage media via telephone line.

Parks et al. **disclose** wherein the control unit (CPU 42) is further able to selectively have the faxing unit transmit the image data stored in the portable data storage media via telephone line (fig. 10, col. 21, lines 10-30).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the communication is bi-directional for data retrieval and faster data process.

Regarding claim 11, Peek discloses the paperless image fax-scanning apparatus of claim 10.

Peek **does not disclose** wherein the control unit is further able to selectively transform the image data stored in the portable data storage media to image data and have the faxing unit transmit the transformed image data via the telephone line.

Parks et al. **disclose** wherein the control unit (CPU 42) is further able to selectively transform the image data stored in the portable data storage media to image data and have the faxing unit transmit the transformed image data via the telephone line (fig.4 and 10, col. 21, lines 10-30).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the communication is bi-directional for data retrieval and faster data process.

Regarding claim 14, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the data storage unit is a floppy disc drive.

Parks et al. **disclose** wherein the data storage unit is a floppy disc drive (fig. 4, col. 21, lines 25-30).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the storage unit could be a variety of different types and forms of storage units, this feature permits storing access for multiple type of data with different transmission capabilities.

Regarding claim 15, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the data storage unit is a removable hard disc drive.

Parks et al. **disclose** wherein the data storage unit is a removable hard disc drive (fig. 4, col. 21, lines 25-30).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the storage unit could be a variety of different types and forms of

storage units, this feature permits storing access for multiple type of data with different transmission capabilities.

Regarding claim 17, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the data storage unit is a Re-Writable Compact Disc (CD-RW).

Parks et al. **disclose** wherein the data storage unit is a Re-Writable Compact Disc (CD-RW) (fig. 4, col. 21, line 28-other storage media).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek wherein the storage unit could be a variety of different types and forms of storage units, this feature permits storing access for multiple type of data with different transmission capabilities.

Regarding claim 18, Peek discloses the paperless image fax-scanning apparatus of claim 1, wherein the control unit is further able to screen out received fax data to decide whether the fax data should be preserved or not (fig. 4, col. 8, lines 44-67).



Art Unit: 2626

3. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peek (US. 6614551) and Parks et al. (US. 5877746) in view of Matsuda et al. (US. 6055067).

Regarding claim 12, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the image scanning unit is a flatbed scanning device.

Matsuda et al. **disclose** wherein the image scanning unit is a flatbed scanning device (figs. 2-3, col. 4, lines 39-41 and lines 55-58).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein documents can scanned / copied manually by way of flatbed scanning, this feature prevents paper feed jams and other component related problems such as that of a roller.

Regarding claim 13, Peek discloses the paperless image fax-scanning apparatus of claim 11, wherein the flatbed scanning device.

Peek **does not disclose** an automatic Document Feeder (ADF) corresponding to the flatbed-scanning device.

Matsuda et al. **disclose** an automatic Document Feeder (ADF) corresponding to the flatbed-scanning device (figs. 2-3, col. 4, lines 41-45).

Art Unit: 2626

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein documents can scanned / copied manually by way of ADF processing, this feature allows a user to process large volumes of documents quickly.

4. Claims 6-8, 16, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peek (US. 6614551) and Parks et al. (US. 5877746) in view of Brusky et al. (US 6487611).

Regarding claim 6, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** a peripheral equipment interface for connecting with peripheral equipment.

Brusky et al. **disclose** a peripheral equipment interface for connecting with peripheral equipment (fig. 1, col. 2, lines 59-62; col. 3, lines 1-3 and lines 58-65).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein additional devices may connect to the standalone fax-scanning device to provide a user with additional device resources.

Regarding claim 7, Peek discloses the paperless image fax-scanning apparatus of claim 6.

Peek **does not disclose** wherein the peripheral equipment interface is a small computer system interface.

Brusky et al. **disclose** wherein the peripheral equipment interface is a small computer system interface (fig. 1, col. 3, lines 62-65).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein additional devices may connect to the standalone fax-scanning device to provide a user with additional device resources.

Regarding claim 8, Peek discloses the paperless image fax-scanning apparatus of claim 6.

Peek **does not disclose** wherein the peripheral equipment interface is Universal Serial Bus (USB) interface.

Brusky et al. **disclose** wherein the peripheral equipment interface is Universal Serial Bus (USB) interface (fig. 1, col. 3, lines 62-63).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein additional devices may connect to the standalone fax-scanning device to provide a user with additional device resources.

Regarding claim 16, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the data storage unit is a personal Computer Memory International Association (PCMCIA) slot.

Brusky et al. **disclose** wherein the data storage unit is a personal Computer Memory International Association (PCMCIA) slot (fig. 1, col. 2, lines 59-67 and col. 3, lines 1-3 and col. 3, lines 30-31).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein the storage unit could be a variety of different types and forms of storage units, this feature permits storing access for multiple type of data with different transmission capabilities.

Regarding claim 19, Peek discloses the paperless image fax-scanning apparatus of claim 1.

Peek **does not disclose** wherein the input interface wirelessly transfers operation signals inputted by a user to other parts of the image fax-scanning apparatus.

Brusky et al. **disclose** wherein the input interface wirelessly transfers operation signals inputted by a user to other parts of the image fax-scanning apparatus (fig. 1, col. 3, lines 60-65).

It would have been obvious to one skilled in the art at the time of the invention to modify Peek and Parks et al. wherein wireless capabilities are implemented for data processing and communication for this type of fax-scanner where as a user may utilize faxing features anywhere.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takahashi et al. (US. 5396341) is cited to show related art with respect to data processing devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tia A Carter whose telephone number is 703 - 306-5433. The examiner can normally be reached on M-F (7:00-3:30).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/899,819

Page 13

Art Unit: 2626

  
TAC  
12/7/04

Tia A Carter  
Examiner  
Art Unit 2626

*KA Williams*

**KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER**